## REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. The Office is respectfully requested to reconsider the rejections present in the outstanding Office Action in light of the foregoing amendments and the following remarks.

Claims 1-20 were pending in the instant application at the time of the outstanding Office Action. Of these claims, Claims 1 and 20 are independent claims; the remaining claims are dependent claims. Claims 1-20 have been rejected and the rejection made final. In response, Applicants have submitted a Request for Continued Examination and this Amendment. Independent Claims 1 and 20 have been amended.

It should be noted that Applicants are not conceding in this application the claims amended herein are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications. Applicants specifically state no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

### Double Patenting Rejections

Applicants acknowledge Claim 1 has been provisionally rejected on the ground of non-statutory double patenting over claim 1 of co-pending Application Serial No. 09/805,336. Applicants respectfully request reconsideration and withdrawal of this

rejection. Should the rejection not be withdrawn, Applicants will defer any further comments on same until an indication of allowable subject matter has been received.

**Rejections under 35 USC 102**

Claims 1-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,918,014 to Robinson (hereinafter "Robinson"). Claims 1-20 also stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,031,932 to Lipsky (hereinafter "Lipsky"). Reconsideration and withdrawal of these rejections is respectfully requested.

As an initial matter, Applicants previously submitted remarks addressing these two references remain equally applicable here, and therefore for the sake of brevity are incorporated by reference as if set forth herein. Applicants additionally wish to present the following remarks.

As has been previously explained, Robinson does not teach the instantly claimed invention and cannot anticipate it under 35 USC 102. As best understood, Robinson is directed at determining which user's like which advertisements based on historical data. *Robinson*, Abstract. In the absence of historical data on an ad, Robinson's invention randomly and passively collects the information necessary to determine which communities prefer which ads. *Id*, Col. 19, lines 6-9. This stands in stark contrast to the instantly claimed invention, wherein active experimentation on a sample of visitors (in some embodiments without regard to their "community" at all, and certainly the present invention contemplates the use of "new" advertisements) via presentation of purposely

varied advertisements (in terms of content, format, etc.) is employed to quickly determine an optimal advertisement for immediate use. *Specification*, [0111]-[0113]. Thus, Robinson is clearly distinguishable from the instantly claimed invention.

As best understood, Lipsky teaches a facility for adjusting an advertising campaign wherein a plurality of advertising alternatives are presented to the entire population of visitors, some visitors being presented a first alternative, other being presented another alternative. *Lipsky*, Abstract. The facility tracks the performance of the advertising campaigns with respect to one another (i.e., the advertising alternatives) and based upon the tracking, the facility attributes a performance score to each of the advertising alternatives and adjusts the allocations for the advertising alternatives accordingly. *Id.* The teachings of Lipsky thus stand in stark contrast to the instantly claimed invention.

Among many other differences, nowhere does Lipsky teach or suggest picking a fraction of visitors to comprise a random sample and experimenting on that random sample using various advertisements to determine an optimal advertisement (as pertains the entire population of current visitors to the website). Lipsky merely tracks the performance of *the current advertisements in use*, and based on the tracking, can regulate up or down the particular advertisements used. *Lipsky*, Abstract. Nowhere does Lipsky teach or suggest that an optimal advertisement can be found via testing various advertising formats not currently in use on a random sample of visitors. That one can notice, over time, that a particular ad is outperforming others and utilize that ad is not the sum total of the instantly claimed invention. Rather, in accordance with the present

invention active experimentation is utilized to determine which, among a plurality of possible advertisements, maximizes a particular variable of current interest to an internet merchant.

The teachings of Lipsky thus stand in stark contrast to the instantly claimed invention wherein a sample is picked and actively experimented upon to determine an optimal advertisement for presentation to visitors to a website, whether or not an advertisement or several advertisements is/are currently in use. Claim 1. In other words, the instantly claimed invention can determine if old or new (not yet presented in an "advertising campaign") are the optimal advertisement for use in a particular, time-sensitive context (e.g. at a particular time for a particular audience, etc). Clearly then the teachings of Lipsky are distinguishable from the instantly claimed invention for at least these reasons.

Solely in an effort to facilitate expeditious prosecution of the instantly claimed application, Applicants have amended the independent claims to recite, *inter alia*:

> (a) receiving configuration data from the Internet merchant, wherein such configuration data comprises: *a sample size* of visitors to the Internet website who are to participate in an experiment; and time-related information concerning the experiment; (b) randomly choosing visitors to the Internet website *to comprise a sample of visitors* to participate in the experiment according to the configuration data; (c) running the experiment according to the configuration data *on the randomly chosen sample of visitors to produce sampling data*, wherein the experiment comprises: *presenting a plurality of varied advertisements* to different visitors within the sample according to the configuration data; and measuring the effectiveness of the *plurality of varied advertisements on the sample*; (d) dynamically determining an optimal advertisement using real time analysis of the sampling data from the experiment; (e) thereafter using the optimal advertisement determined in step (d); and (f) repeating steps (a) - (e) using sampling data obtained in step (c) as configuration data in step (a).

Claim 20 (emphasis added). Claim 1 contains similar amendments. These amendments are intended to clarify that active experimentation is conducted upon a sample of visitors to a website in order to determine the optimal advertisement in terms of form, content, etc., to be used by an internet merchant, even if the advertisements haven't been used before. Therefore, Applicants respectfully submit that the instantly claimed invention is clearly distinguishable from both Robinson and Lipsky. Thus, Applicants respectfully request reconsideration and withdrawal of these rejections under 35 USC 102.

**Additional Claim Amendments**

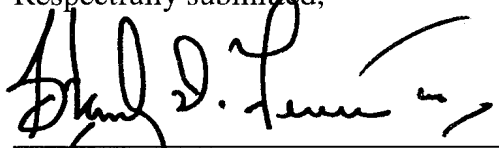
It should be noted that Applicants have amended certain dependent claims (11, 12, 14, 17, 18 and 19). Applicants do not intend that these amendments change the scope of the claims and are presented solely for the purpose of ensuring clarity and conformity among the various independent and dependent claims. Applicants specifically state no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

**Conclusion**

By virtue of dependence from what is believed to be allowable independent Claim 1, it is respectfully submitted that Claims 2-19 are also presently allowable. Thus, it is respectfully submitted that the instant application, including Claims 1-20, is presently in condition for allowance. Notice to the effect is hereby earnestly solicited.

Should the claims not be in condition for immediate allowance, the courtesy of a telephone interview is requested prior to the issuance of a further Office Action.

Respectfully submitted,



Stanley D. Ference III
Registration No. 33,879

**Customer No. 35195**
FERENCE & ASSOCIATES LLC
409 Broad Street
Pittsburgh, Pennsylvania 15143
(412) 741-8400
(412) 741-9292 - Facsimile

Attorneys for Applicants